

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

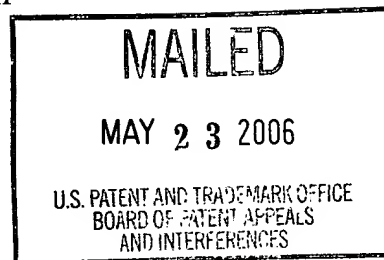
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IRWIN JEROLD SINGER
and CHARLES EDWARD BOLIAN II

Appeal No. 2006-0806
Application 09/954,807

ON BRIEF



Before KIMLIN, WARREN and FRANKLIN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: claims 1 through 11 under 35 U.S.C. § 102(b) as being anticipated by Midkiff (answer, pages 3-5); claims 13 through 26 and 29 through 31 under 35 U.S.C. § 103(a) as being unpatentable over Midkiff in view of Drew (answer, pages 5-9); and claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Midkiff in view of the admitted prior art at page 1, l. 25, to page 2, l. 1, of the specification (answer, pages 9-10).¹

¹ Claim 27 is also of record and have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b). Claims 1 through 11 and 13 through 31 are all of the claims in the application.

We refer to the answer and to the brief and reply brief for a complete exposition of the positions advanced by the examiner and appellants.

The dispositive issue in this appeal is the interpretation to be made of the claim language “the [spunbond] nonwoven is bonded with a pattern having continuous bonded areas defining a plurality of discrete unbonded areas” which appears in each of independent claims 1, 13 and 29. We interpret the claim language by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the specification unless another meaning is intended by appellants as established in the written description of the specification, and without reading into the claims any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The examiner finds that the disclosure at Midkiff col. 7, ll. 55-57, reads on the subject claim language. Appellants reply that the claim language is specifically defined at page 8, l. 28, to page 9, l. 11, noting that the “continuous bonded areas . . . encircle, or surround each unbonded area” (e.g., reply brief, page 2; original emphasis deleted).

We find that in context, Midkiff would have disclosed a process using a “hot air knife” to pre- or primary bond the just produced spunbond web “to give it sufficient integrity, i.e., increase the stiffness of the web, for further processing,” and then a “through-air bonding” as a “secondary bonding step” which “provides sufficient heat to bond fibers not bonded” by the hot air knife, the combination producing “high stiffness in the web” which “creates bonds at almost every fiber crossover point, thereby restricting movement of the majority of the web” (col. 7, ll. 14-57; see also col. 4, l. 24, to col. 5, l. 6, and col. 5, ll. 21-43). Midkiff would have further described the result by disclosing that “[t]hermal point bonding by contrast results in the bonds at discrete points, thereby allowing the fibers between the bond points the freedom to bend and rotate individually and so producing a much smaller increase in stiffness and so is not an acceptable bonding process for this invention” (col. 7, ll. 57-62).

The examiner submits that “the web of Midkiff has bonds at almost every fiber crossover point” which reads on the structure specified by the subject claim language

because (1) each fiber crossover point at which the fibers are bonded is a “continuous bonded area[]”, (2) each fiber crossover point at which the fibers are not bonded is a “discreet unbonded area[]”, (3) even the areas along all of the fibers of the web that are not at fiber crossover points (both bonded and unbonded fiber crossover points) are “discreet unbonded areas” and (4) the bonded fiber crossover points “defin[e]” the “discrete unbonded areas” of the web . . . since the ‘discrete unbonded areas’ are all the “areas” of the web other than the bonded fiber crossover points (equivalently, the continuous bonded areas”). [Answer, page 10.]

In reply, appellants submit that “[t]wo bond points along an unbonded line are not equivalent to a “continuous bonded area encircling or surrounding” an unbonded area (reply brief, page 2).

We agree with appellants. We note that the subject claim language specifies that “the nonwoven web is bonded with a pattern” and the definition in the specification specifies “a fabric pattern.” Thus, it is the nonwoven web in which the bonded areas are “continuous,” and not a crossover “point” area on a single fiber. Indeed, we find that Midkiff would have disclosed that the primary and secondary “air” heat treatments result in random bonding of “almost every crossover point,” which disclosure, as explained by the examiner, would not reasonably appear to result in the “pattern” required by the subject claim language.

Accordingly, the examiner has not established a *prima facie* case of anticipation within the meaning of 35 U.S.C. § 102(b) and of obviousness within the meaning of 35 U.S.C. § 103(a), and therefore, we reverse the grounds of rejection.

The examiner’s decision is reversed.

Remand

We remand the application to the examiner for consideration of issues raised by the record. 37 CFR § 41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

Appellants acknowledge in the background of the specification that they are aware of a commercial product which, on this record, appears to differ from the claimed protective material encompassed by the appealed claims in that the “nonwoven fabric was not electret treated” (page 3, ll. 9-22). We find no submission of information with respect to this acknowledged prior art on

the record. *Cf. In re Nomiya*, 509 F.2d 566, 570-71, 571 n.5, 184 USPQ 607, 611, 611 n.4 (CCPA 1975) (“We see no reason why appellants’ representations in their application should not be accepted at face value as admissions that Figs. 1 and 2 may be considered “prior art” for any purpose, including use as evidence of obviousness under § 103. [Citations omitted.] By filing an application containing Figs. 1 and 2, labeled prior art, *ipsissimis verbis*, and statements explanatory thereof, appellants have conceded what is to be considered as prior art in determining obviousness of their improvement.”). The electret treatment of a nonwoven fabric was known in the art at the time this application was filed as evinced by Midkiff (col. 8).

Furthermore, in view of the issues thus raised by appellants’ acknowledged prior art, we decline to exercise our authority under 37 CFR § 41.50(b) (2005) and enter on the record a new ground of rejection of claims 30 and 31, presented in the amendment filed March 11, 2003, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. These product claims encompass any article that is in contact with the protective material encompassed by claim 1 or located within a storage sleeve encompassed by claim 29, respectively. We fail to find any disclosure in the written description in the specification as filed which would reasonably convey to a person skilled in this art that appellants were in possession of the invention defined by these claims including all of the limitations thereof, at the time the application was filed. Indeed, we find that, *prima facie*, the written description of the specification would have conveyed to this person that appellants’ invention is the protective wrap or sleeve *per se*, and not an article protected therewith. Thus, as a matter of fact, these claims encompass embodiments which are completely outside the scope of the specification. *See generally, In re Alton*, 76 F.3d 1168, 1172, 1175-76, 37 USPQ2d 1578, 1581, 1583-84 (Fed. Cir. 1996), citing *In re Wertheim*, 541 F.2d 257, 262-64, 191 USPQ 90, 96-97 (CCPA 1976).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to (1) require appellants to submit information under 37 CFR § 1.105(a)(1)(vii) (2005) with respect to the acknowledged commercial product, and determine whether such information provides sufficient evidence along with Midkiff and/or any other applicable prior art the examiner deems appropriate, on which to base a new ground of rejection of the appealed claims under 35 U.S.C. § 103(a); (2) enter on the record a new ground of

rejection of claims 30 and 31 under 35 U.S.C. § 112, first paragraph, written description requirement, that we have set forth above; and (3) enter any other ground(s) of rejection the examiner deems appropriate.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

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Application 09/954,807

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